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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,116	08/10/2001	Peter R. Anderson	47079-066	6267

7590 05/13/2003

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EXAMINER
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MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/13/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

**Office Action Summary**

Application No.

09/928,116

Applicant(s)

ANDERSON ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Species I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that no serious burden was placed on the Examiner involving the search. This is not found persuasive because a proper traversal to a restriction requirement with respect to an election of species requires that the applicant demonstrate either 1) there is a disclosed relationship between the inventions (MPEP §808.01(a)) or 2) the inventions of the species are not patentably distinct from each other and therefore obvious variations (MPEP §806.04(h))

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-23 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species II and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (WO 98/09259) in view of Gasper et al. (US Patent No. 6,213,873).

Bennett discloses a method and apparatus for conducting a game of chance on a gaming machine controlled by a processor wherein an array of locations displayed on a video screen (page 3, lines 23-24) is alternatively selectable by both the player and the processor (FIG 2 and

page 2, lines 26-29) for placing of first and second symbol types (FIG 3). A payout is awarded based upon the outcome of the game (page 2, line 29). Bennett discloses that in the event the player wins the game by aligning three of the selected zones in a straight line, the machine will pay a prize equivalent to the sum of the prizes (page 4, lines 15-18). Bennett does not disclose the payout for the other two possible outcomes. However, it is notoriously well known in the art that there is a payout associated with all possible outcomes of a gaming event wherein a first payout is paid for a win, a second payout is used for a loss and a third for a draw. Such a well-known example is in blackjack where a payout is positive if the player has won, neutral if the player and dealer have drawn and negative if the dealer has won. Incorporation for a payout associated with each possible outcome is therefore notoriously well known and would have been obvious to one skilled in the art.

However, Bennett et al. do not disclose that the processor varies its style of play throughout the game.

Gaspar et al. teach of games of strategy that are designed to be executed on a computer (Column 1, lines 26-28) wherein there are alternate selections between the player and the processor. Gaspar et al. disclose in such strategy games, it is advantageous to allow the processor to vary the winning strategy for selections with each successive turn (Column 2, lines 5-15). The probability of using the winning strategy is thus varied with each successive turn. By adapting the response of the processor to the player's skill (Column 2, lines 31-34), the probability of using a winning strategy is based not upon a set function for playing, but on a variance in response to game plays. Gaspar et al. disclose that by varying the winning strategy for each turn, the system is able to control the percentage of wins by the player (Column 2, lines

5-17). Though Gasper et al. do not explicitly link the probability for using a winning strategy as a function of the number of times such successive selections have been made and increase about 10% with each selection, such a choice as a means to adapt the winning strategy would have been one of obvious to one of ordinary skill in the art in view of the disclosure of Gasper et al. The purpose of Gasper et al. is to keep a solid winning percentage rate for the player in order to keep the player from getting discouraged. It is notoriously well known in the gaming world that this percentage must in addition also be controlled in order to maintain proper yield and therefore, absent a showing of criticality, the manner in which this percentage would be maintained as a means of varying the selections of the processor to keep the desired level of performance would be obvious to one of ordinary skill in the art. Variance based upon a set performance schedule would control the winning percentage of the player in the same manner as varying the level of computer play based on player decision as both are recognized to result in known outcomes for a set percentage of the time thus both would provide adequate means to control the winning percentage of the gaming machine and are thus design choices which would be obvious to one of ordinary skill in the art.

It would have been obvious to one of ordinary skill in the art to apply the teachings of Gasper et al. to the disclosure of Bennett. Though the teachings of Gasper et al. are directly embodied in example as a chess game, they are disclosed to be related not only to chess but also to games of strategy, thus directly relate to the tic-tac-toe game as disclosed by Bennett. Gasper et al. teach that games of strategy that use no adaptive strategy can quickly overwhelm players of limited skill (Column 1, lines 57-62) while games of strategy that only allow the adaptive strategy to be defined prior to competition (Column 1, lines 65-67; Column 2, lines 1-4) can

discourage play. Further, Gasper et al. teach that by using a processor that uses an adaptive strategy, the player is assured of continuously learning the strategy related to the game as well as not becoming unduly discouraged by repeated loss (Column 2, lines 16-18). Gasper et al. also teach that by using adaptive selection, the winning rate of the player can be controlled. One of ordinary skill in the art would thus be motivated to combine the teachings of Gasper et al. with that disclosed by Bennett in order to allow the bonus game of Bennett to employ an adaptive strategy wherein the player will not become frustrated with or discouraged by play which are disadvantages disclosed by Gasper et al. for not using the adaptations between turns. Further, as disclosed by Gasper et al. when the strategy for choosing a winning move is adapted, the player is more likely to learn the strategy involved with the game as well as not becoming discouraged. Therefore, a further reason for using this adaptive strategy lies in the fact that it is notoriously well known in the gaming art that players are more likely to play games they perceive they have a better chance of winning and do not become discouraged with, which will result in the Bennett slot machine when adaptive strategy is used to allow players to learn the strategy involved thus generating a greater revenue for the casino.

### ***Response to Arguments***

Applicant's arguments, see pages 4 and 5, filed 07 January 2003, with respect to the rejection(s) of claim(s) 1-10 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the disclosure of Gasper et al. (US Patent No. 6,213,873).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,461,241:** Gaming machine that provides a bonus round wherein the user can be presented with a number of selection games including chess and tic-tac-toe wherein there are alternate selections between the processor and the player.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

*cmm*

cmm  
May 6, 2003

*Michael O'Neill*  
MICHAEL O'NEILL  
PRIMARY EXAMINER